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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,714	08/25/2003	Thomas J. Kelly	08350.3304-05	9838

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EXAMINER

GYORFI, THOMAS A

ART UNIT	PAPER NUMBER
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2135

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/646,714

Applicant(s)

KELLY ET AL.

Examiner

Tom Gyorfi

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

DETAILED ACTION

1. Claims 1-23 are pending examination.

Information Disclosure Statement

2. In an attempt to fulfill Applicant's duty to disclose information which is material to patentability according to 37 CFR 1.56, Applicant has submitted a large number of documents for the Examiner to consider. However, it appears from a cursory review of the documents that the vast majority of them are not material to patentability and should not have been submitted. In fact, the sheer number of documents creates an undue burden on the Examiner since if each document is material to patentability, each document must be carefully considered.

According to MPEP 609, (emphasis added): "Although a concise explanation of the relevance of the information is not required for English language information, applicants are encouraged to provide a concise explanation of why the English-language information is being submitted and how it is understood to be relevant. Concise explanations (especially those which point out the relevant pages and lines) are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability or where a large number of documents are submitted and applicant is aware that one or more are highly relevant to patentability."

Additionally, Applicant is made aware of the court decision in Penn Yan Boats, Inc. v. Sea Lark Boats, Inc. et al., 175 USPQ 260 (DC SFla, 1972) which stated that

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"Applicant has obligation to call most pertinent prior patent to attention of Patent Office in a proper fashion and to attempt to patentably distinguish his claimed invention from disclosure of patent; failure to take these affirmative steps, particularly when coupled with misrepresentations made to the Patent Office, renders unenforceable the patent issued on his application." In that case a good reference was buried in the mountain of prior art in the case and was never pointed out by the Applicant.

Applicant is reminded that only documents which are "material to patentability" should be submitted. See 37 CFR 1.56 for definition of materiality.

Accordingly, after performing a cursory review of the information disclosure statements, Examiner has considered only those references that were deemed even remotely pertinent to the instant invention. Applicant should submit a new IDS containing only those documents which are material to patentability, and Applicant should call Examiner's attention to particular passages and/or figures of particular documents. Resubmission of the previously submitted documents is not necessary.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7, 10-18, and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,052,788 (hereinafter, "Wesinger").

Regarding claim 1:

Wesinger discloses a system for managing communications comprising: a first off-board system connected to a first off-board data link, wherein the off-board module is remotely located from the work machine (Figure 1; see also col. 8, lines 15-20); a gateway embedded in the work machine including: a communication application that uses a translation table stored in the gateway for converting information from a first protocol format to a second protocol format (col. 7, lines 45-53; col. 8, lines 35-55), and a firewall application that is configured to perform, when executed by a processor, a firewall process that controls access to proprietary information associated with the work machine (col. 9, lines 20-67), wherein the firewall process determines whether a message received from the first off-board system is authorized based on a profile associated with the first off-board system, whether a message received from the first off-board module includes a parameter identifier corresponding to one of a number of parameter identifiers included in the translation table, and denies access to the proprietary information based on at least one of (i) a determination that the parameter identifier does not correspond to one of the number of parameter identifiers in the translation table and (ii) the profile associated with the off-board system (Ibid, and col. 16, lines 13-37).

Regarding claims 12 and 23:

Wesinger discloses a method (and computer program for implementing same) for managing communications comprising: receiving a request generated by a first off-

board system and transmitted on a first off-board data link (col. 6, lines 60-67); and invoking a firewall application that performs a firewall process including the steps of: identifying a destination device associated with the request (col. 8, lines 15-35), determining whether the request is authorized based on a profile associated with the first off-board system (col. 16, lines 13-37); determining whether the request includes a parameter identifier that matches a parameter identifier included in a memory location maintained by the gateway (col. 15, lines 1-13), and denying or granting access to proprietary information based on the two determining steps (Ibid).

Regarding claim 2:

Wesinger further discloses wherein the firewall process denies or grants access to the proprietary information based on a profile associated with a user operating the first off-board system (col. 16, lines 13-25).

Regarding claims 3 and 13:

Wesinger further discloses wherein the profile is associated with a user of the first off-board system and defines a type of access to a selected portion of the proprietary information (Ibid).

Regarding claims 4 and 14:

Wesinger further discloses wherein the proprietary information includes a parameter identifier data value (col. 15, lines 1-13).

Regarding claims 5 and 15:

Wesinger further discloses wherein the firewall process allows the first off-board system to access the proprietary information to access the proprietary information when the parameter identifier in the message matches at least one parameter identifier included in the translation table (col. 15, lines 1-13).

Regarding claims 6 and 16:

Wesinger further discloses wherein the gateway executes the communication application to convert the request to a different protocol format when the firewall process allows the off-board system to access the proprietary information (col. 11, lines 15-25).

Regarding claims 7 and 18:

Wesinger further discloses wherein the firewall process denies access to an on-board module based on parameter information included in a second message (col. 10, lines 51-56).

Regarding claims 10 and 21:

Wesinger further discloses wherein the firewall application performs a second firewall process that controls access to the proprietary information based on a timing profile associated with the type of request (col. 15, lines 10-15).

Regarding claims 11 and 22:

Wesinger further discloses wherein the request is a batch request including multiple sub-requests associated with the proprietary information based on a determination that parameter identifiers associated with a respective portion of the sub-requests do not match any of the parameter identifiers included in the translation table (col. 14, lines 23-30).

Regarding claim 17:

Wesinger further discloses wherein the memory location is included in a translation table used by the communication application to convert parameter data values to different formats (col. 7, lines 45-53).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8, 9, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wesinger as applied to claims 1 and 16 above, and further in view of Bade et al. (U.S. Patent 6,778,837).

Regarding claims 8 and 19:

Wesinger does not explicitly disclose wherein the work machine moves between, or within, a work environment and the firewall controls access to proprietary information located in a remote location based on the position of the work machine. However, Bade discloses this limitation (col. 2, lines 38-48). It would have been obvious to one of ordinary skill in the art at the time the invention was made to permit or deny access to [mobile] devices based on location as disclosed by Bade. The motivation for doing so would be to prevent unauthorized users from accessing proprietary information in the event the device was stolen or misplaced (Ibid, and col. 2, lines 1-10).

Regarding claims 9 and 20:

Wesinger and Bade disclose or suggest all the limitations of claims 8 and 19 above. Wesinger and Bade further disclose wherein the gateway receives the message from a second gateway included in the second work machine that has moved into the communication range of the work machine (Wesinger: Figure 1, and col. 7, lines 12-35; Bade: col. 3, lines 35-45).

Conclusion

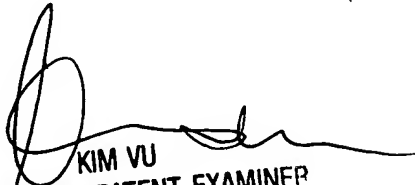
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Patent 6,317,838 to Baize et al.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Gyorfi whose telephone number is (571) 272-3849. The examiner can normally be reached on 8:30am - 5:00pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TAG
12/19/06


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